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EXAMINER

AUGUSTIN, EVENS J

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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/852,611
Filing Date: May 09, 2001
Appellant(s): SHAN ET AL.

Joseph G. Swan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/25/2010 appealing from the Office action mailed 07/27/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The 101 and the 112 rejections have been withdrawn.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 10, 19-25, 27-33, 35, and 37-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gerace, U.S. Patent No. 5,848,396.
3. As per claims 1, 10, 19-25, 27-33 35, and 37-40, Gerace teaches a method for targeting ads to a user comprising:
 - A. storing customer profile information (abstract; figures 3B-D; column/line 4/56-5/15; column/line 5/54-6/40)

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- B. storing customer web log information (abstract; figures 3F-G; column 5, lines 26-40; column/line 6/40-7/24)
 - C. storing promotion attributes (abstract; figures 5A-D; column 5, lines 15-40)
 - D. inputting profile, web log and promotion attributes into a model (abstract; column 2, lines 10-23 and 35-53; column 13, lines 1-26; column 15, lines 25-44; column 18, lines 10-26; column/line 18/51-19/33) for automatically targeting sales promotions to a customer (abstract; column 1, lines 5-14; column 2, lines 1-65; column 9, lines 8-30; column 13, lines 22-26; column 22, lines 53-65; column/line 26/48-27/50; column/line 28/10-29/20)
 - E. simulating conversion of a shopper into a buyer (column 2, lines 35-53; column 13, lines 1-26; column 18, lines 10-25), varying a promotion based on the model and observing the results (column 1, lines 5-13; column 2, lines 10-23 and 35-53; column 5, lines 8-26; column 7, lines 23-38; column 18, lines 10-25) and continuously updating the model (abstract; column 2, lines 10-23 and 35-53; column 15, lines 25-44; column 18, lines 10-26; column/line 18/51-19/33)
4. Regarding the calculating a percentage likelihood that a customer will become a purchaser, Gerace teaches using input such as buyer purchases (column 2, lines 35-42; column 9, lines 8-15; column 13, lines 1-32) to adjust how ads are displayed to customers (column 18, lines 10-25). Therefore, as some customers are excluded from the population of customers who are to view ads (column 18, lines 18-26) the system of Gerace necessarily calculates a percentage likelihood that one customer is more likely to make a purchase over another.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 6-9, 13, 15-18, 26, 34, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace, U.S. Patent No. 5,848,396 in view of itself.
7. As per claims 4, 6, 13, 15, 26, 34 and 41, Gerace teaches using a regression analysis to match advertisements to customers (abstract; column 2, lines 10-23 and 35-53; column 15, lines 25-44; column 18, lines 10-26; column/line 18/51-19/33). Regression (e.g. linear, non-linear, logarithmic) and decision modeling (e.g. utility functions) are well-known methods for analyzing data. Therefore, it would have been obvious to one of ordinary skill to use whatever form of analysis he/she is most comfortable with and/or produces the best results (In re Wolfe, 116 USPQ 443, 444 (CCPA 1961)).
8. As per claims 7-9, 16-18, and 42, Gerace teaches using profile, web log and promotion attributes to better target ads (abstract; figures 3A-G and 5A-D; column/line 4/56-7/24). Therefore, it would have been obvious to one of ordinary skill to collect whatever customer, customer internet history, or advertisement data necessary in order to more effectively target ads to customers (In re Wolfe, 116 USPQ 443, 444 (CCPA 1961)).

(10) Response to Argument

Argument #1: Prior art does not teach the aspect of storing promotion attributes:

Response #1: Firstly, appellant would lead one skilled in the art to believe that advertisement is not related to promotion ("Gerace only appears to distinguish advertisements based on their exact makeup, not on the terms of any promotions that might be included within them" brief, page 13, paragraph 2). As such promotion has a widely held in the art to be the furtherance of the acceptance and sale of merchandise through advertising, publicity, or discounting. A promotion might be a short-term price reduction, contest or sweepstakes, package giveaway, or free sample offer. A promotion might also be a single mailing within a direct mail campaign or series of advertisements that make up part of an ongoing print advertising campaign. Therefore, advertising is act of furthering sales, hence promotion. Appellant did not lexicographically define the word promotion. Rather appellant gave broad, open-ended description such as "promotion **can** consist of ... (see page 11 of brief).

The prior art by Gerace is regarding recording user/customer/client tendencies in order to provide customized or targeted advertisement. For example, when a use goes on the web and browses through stock market data, weather or sports (C4, L6-7), Gerace **records/logs** the user's selection (C4, 12) to create a customer preference or profile based on various categories. The various categories of interest include stock trading portfolio, sports, news, weather, theater and television schedules, telephone directory, travel data, classified ads and personals information, and the like(C6, L28-32). Based on the created customer profile, Gerace provides the user targeted advertisement that matches the user preference (C4, L30-36). Therefore, the attributes of the promotion/advertisement are the created customer profile/preferences, since the ads are

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based on those attributes. Gerace also uses information/data collected from the user to create or simulate a behavioral or psychographic profile (C2, L4-5). The system also keeps track of the user's activities on the web (web log) (C6, L47-57). Gerace also teaches the aspect of providing the user with discount fares (C32, L14).

Furthermore, Gerace use regression analysis to investigate the degree to which variations on the recorded customer profile are correlated in order to better fine tune the targeted ads (C2, L43-54).

Appellant appears to be arguing elements that were not claimed ("Gerace says nothing at all about distinguishing advertisements by considering how such different kinds of material might be substantively related to each other" page 13, paragraph 2 of brief).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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